



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,839	10/11/2001	Andrew Egendorf	7178-207	4483

27383 7590 10/22/2002

CLIFFORD CHANCE US LLP
200 PARK AVENUE
NEW YORK, NY 10166

EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/975,839

Applicant(s)
Egendorf

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 13, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1
2 1. Receipt of the remarks regarding the Office Action mailed dated July 16, 2002 is
3 acknowledged. In consideration of the remarks made toward the ownership of the Egendorf
4 '489 application, the 103(a) rejection using the Egendorf '489 application is hereby rescinded.
5 However, applicant's arguments with respect to claims 31-45 are considered moot in view of
6 the new ground(s) of rejection.

7
8
9 *Claim Rejections - 35 USC § 103*

10
11 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
12 obviousness rejections set forth in this Office action:

13
14 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
15 in section 102 of this title, if the differences between the subject matter sought to be patented and the prior
16 art are such that the subject matter as a whole would have been obvious at the time the invention was made
17 to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
18 negated by the manner in which the invention was made.
19

20 3. Claims 31-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silver et
21 al (hereinafter "Silver", US 5,146,491) and Carnegie Mellon University Information
22 Networking Institute, "Internet Billing Server Prototype Scope Document INI Technical
23 Report 1993-1" (October 14, 1993) (hereinafter "IBS") in view of each other.

24

1
2 As in claims 1, 32, 44, 45, Silver discloses a telephone billing method for a plurality
3 of customers and plurality of vendors of products or services for transactions between a
4 plurality of vendors of products or services for transactions between a purchasing customer, of
5 the plurality of customers and a selling vendor of the plurality of vendors (see Silver, col. 1, ll.
6 60-66; col. 2, ll. 14-26),

7 wherein, for each purchase transaction between the purchasing customer and the selling
8 vendor, a first amount is charged to the purchasing customer and second amount is remitted to
9 the selling vendor (see Silver col. 1, ll. 23-34), the method comprising the steps by a third
10 party to the purchase transaction of:

11 (a) establishing a billing agreement with the purchasing customer to permit the third
12 party to charge the purchasing customer and to remit a selling vendor for a purchase
13 transaction (see Silver, col. 1, ll. 23-28);

14 (b) establishing a remitting agreement with the purchasing customer to permit the third
15 party to charge the purchasing customer and to remit to a selling vendor for a purchase
16 transaction (see Silver, col. 1, ll. 23-28);

17 (c) receiving authorization over the Internet from the purchasing customer to charge
18 the first amount to the purchasing customer without previously receiving a request from the
19 selling vendor to charge the first amount to the purchasing customer (see Silver, col. 1, ll. 35-
20 47);

1 (d) charging the first amount to the purchasing customer in accordance with the billing
2 agreement (see Silver, col. 2, ll. 15-27); and

3 (e) remitting the second amount to the selling vendor in accordance with the remitting
4 agreement (see Silver, col. 2, ll. 15-27).

5 as in claim 33, the communications link comprises a communications link through
6 equipment of the third party (see Silver col. 1, ll. 60-66).

7 as in claims 34-36, wherein no credit card account number of the purchasing customer
8 and no bank account number of the purchasing customer is transmitted by the third party to the
9 selling vendor prior to the step of remitting (see Silver, col. col. 3, ll. 16-31)

10 as in claim 37, wherein the third party is a cable television company, a company
11 offering financial services, and Internet access provider, or a telephone company (see Silver,
12 Abstract).

13 as in claim 38, the step of obtaining approval for charging the first amount from a party
14 other than the purchasing customer and selling vendor prior to the step of charging (see Silver,
15 col. 1, ll. 22-27).

16 as in claim 39, the party other than the purchasing customer and selling vendor is a
17 bank, a company offering financial services, a credit card company, an Internet access
18 provider, or the third party (see Silver, col. 1, ll. 23-34).

19 as in claim 40, the step of charging comprises sending a bill or charging an account
20 with a bank, a cable television company, an company offering financial services, a credit card

1 company, an Internet access provider, a telephone company, or a third party (see Silver, col.
2 1, ll. 35-41).

3 as in claim 41, the remitting comprises sending a check or crediting an account with a
4 bank, cable television company, a company offering financial services, a credit card company,
5 an Internet access provider, a telephone company, or a third party (see Silver, col. 2, ll. 14-
6 26).

7 as in claim 42, the second amount is less than the first amount (see Silver, col. 2, ll.
8 14-27).

9 as in claim 43, the step of remitting is performed before the step of charging (see
10 Silver, col. 4, ll. 13+).

11 IBS discloses an Internet billing Server that can provide billing and advertisement
12 (directory) services over the Internet between customers and vendors (see whole article).

13 In view of the IBS's, teaching it would have been obvious for an artisan at the time the
14 invention was made to substitute the Internet Billing Server ("IBS") for the notoriously old and
15 well known Billing computer disclosed in Silver because an artisan of ordinary skill in the art
16 would have recognized that such a modification would have constituted a substitution of art
17 recognized equivalents in as much as both the IBS and the Billing computer provide a user
18 access to information/services over a network and charging a user for services rendered by the
19 system and billing for items/services made with a particular vendor. Therefore such a

1 modification would have constituted an obvious expedient well within the ordinary skill in the
2 art.

3 On the other hand, it would have been obvious for an artisan at the time of the
4 invention of IBS to integrate/implement the telephone billing method of Silver because an
5 artisan at the time of the invention would recognize the simplicity and convenience of utilizing
6 the Silver method of receiving goods and services over a network, whereby the address and
7 billing information is automatically received by the system so that the user need not to enter
8 such information when using the system, and that charges due to system usage are considered
9 separate from customer purchases made from a vendor through the system. Thus such methods
10 would have been an obvious expedient to one of ordinary skill in the art.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

5. Response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

1 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
2 Trademark on February 25, 1997 at 1 195 OG 89.

3
4 
5 DSF
6 October 17, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600